

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: SORKIN; Felix L.

SERIAL NO.: 10/688,184

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EXAMINER: Dreidame, H.M.

TITLE: CONSTRUCTION CHAIR FOR USE WITH TILT WALL CONSTRUCTION

Amendment A: REMARKS

Upon entry of the present amendments, previous Claims 1 - 20 have been canceled and new Claims 21 - 37 substituted therefor. Reconsideration of the rejections, in light of the forgoing amendments and present remarks, is respectfully requested. The present amendments have been entered for the purpose of distinguishing the present invention from the prior art.

In the Office Action, it was indicated that Claims 1, 2, 9 and 10 were rejected under 35 U.S.C. § 102(b) as anticipated by the Hartzheim design patent. Claims 1, 8, 12, 13 and 16 was rejected under 35 U.S.C. § 102(b) as anticipated by the Hernandez design patent. Claim 5 - 7 and 11 were rejected under 35 § U.S.C. 103(a) as being unpatentable over the Hartzheim design patent in view of the Sorkin '095 patent. Claims 15 and 17 - 20 were rejected under 35 § U.S.C. 103(a) as being obvious over the Hernandez deign patent in view of the Sorkin '095 patent. Claim 2, 12 and 19 were objected to under 37 U.S.C. § 112, second paragraph. Claim 1, 3 and 12 were also objected to because of minor informalities.

As an overview to the present reply, Applicant has introduced independent Claims 21, 31 and 35 so as to emphasize the "pin member extending downwardly from the flat bottom surface of the leg of the chair. Independent Claim 35 also specifies that the pin is of "an inverted conical shape and has a point formed at an end thereof opposite the flat bottom surface". Independent Claim 21

incorporates the limitations of previous independent Claim 1, along with the limitations of dependent Claim 5. Independent Claim 31 incorporates the limitations of independent Claim 12, along with the limitations of dependent Claim 15. Independent Claim 35 incorporates the limitations of previous independent Claim 17, along with the limitations of dependent Claim 18.

The importance of the pin member was particularly recited in paragraph [0037] of the original specification, in pertinent part, as follows:

Pin member 28 extends vertically downwardly from the flat bottom surface 30. The pin member 28 is only a single pin member having an inverted conical shape. In particular, a point 50 is formed at an end of the pin member 28 opposite the flat bottom surface 30. As a result, each of the legs 14, 16, 18 and 20 will have only a minimal profile on the exposed surface of the wall upon which the chair 10 is placed.

Applicant respectfully contends that the prior art combination neither shows nor suggests such a limitation.

Fundamentally, in order for prior art references to be properly combined so as to show “obviousness”, there must be some teaching or suggestion in the primary reference that would be indicative of a reason for combining the primary reference with the secondary reference. In the Official Action, the only primary references were a design patent to Hernandez and a design patent to Hartzheim. Design patents, by their very nature, provide absolutely no description whatsoever, other than the illustrations. As such, there can inherently be no language within such design patents to suggest a combination with features from a utility patent. Whenever a design patent is used as a primary reference, it can be only hindsight analysis as to interpreting any basis for combining such a primary reference with a secondary reference. For example, if the Hartzheim patent is to be combined with the Sorkin ‘095 patent, then where is the teaching or suggestion in the Harztheim

patent to suggest such a combination? Additionally, if the Hernandez patent is to be combined with the teachings of the Sorkin ‘095 patent, then where are the teachings in the Hernandez patent to suggest such a combination?

As limited herein, each of the independent Claims 21, 31 and 35 emphasizes that there is a pin member that extends downwardly from the flat bottom surface. The purpose of this pin member is to provide “only a minimal profile of the exposed surface of the wall upon which the chair is placed”. In the Sorkin ‘095 patent, the only purpose for the “projections 36, 37, 38, 39, 42 and 48” is to enhance the structural stability and strength of the chair. In column 5, line 40 - 50, it was stated that:

Importantly, the configuration of the projections 36, 37, 38, 39, 42 and 48 enhances the structural stability and strength of the chair 10 of the present invention. Whenever a load is applied to the receiving area 12 of the chair 10, then this load will cause the projections to bite, to engage or to become embedded in the deck under which the chair 10 is placed. As such, the projections will facilitate the ability of the legs 14 and 18 to resist deformation under the presence of a load. As a result, it is possible to create the chair 10 without having an internal structural ring or other structural members.

There is no recitation within the Sorkin ‘095 patent that the purpose of such projections is to minimize the profile on the exposed surface of the wall upon which the chair is placed. It is unlikely that the Sorkin ‘095 patent would recite such a benefit since the purpose of the Sorkin ‘095 patent is to be placed upon a deck so as to support the chair on an underlying surface. In the present case, when the tilt-wall is supported in an upright position, the vertical surface of the wall will be exposed on the exterior. As such, such small projections will minimize any potential adverse appearance resulting from the original placement of the chair. This feature was neither shown nor suggested by the Sorkin ‘095 patent.

Relative to the independent claims, since neither the Hartzheim design patent nor the Hernandez design patent would suggest any need for combining with the prior art reference, Applicant's attorney respectfully contends that the illustrations of the secondary reference (i.e. the Sorkin '095) are largely irrelevant. Fundamentally, the Hartzheim patent does not show a pin member. The Hartzheim patent actually shows a ring connecting the legs. The Hernandez patent does not show a "flat bottom surface" from which the pin member can extend. As such, the prior art combination neither shows nor suggests the structure of the present invention as defined by independent Claims 21, 31 and 35.

Relative to the formality objections, Applicant's attorney has removed the offending statement from paragraph [0027] of the original specification. As such, Applicant's attorney contends that the disclosure is no longer "so incomprehensible" as to preclude a reasonable search of the prior art by the Examiner. Applicant has removed the offending term "substantially" from Claims 2, 12 and 19 as reflected in new dependent Claims 22 and 36. A correction of the typographical errors associated with the word "position" in Claims 1, 3 and 12 has been corrected.

Dependent Claims 22 - 24 herein reflect the limitations found in previous dependent Claims 22 - 24, respectively. Dependent Claims 256 - 30 reflect the limitations found in original dependent Claims 6 - 11, respectively. Dependent Claims 32 and 33 correspond, respectively, to the limitations found in original dependent Claims 13 and 14. Dependent Claim 34 corresponds to the limitations of previous dependent Claim 16. Dependent Claims 36 and 37 correspond, respectively, to the limitations found in original dependent Claims 19 and 20.

Based upon the foregoing analysis, Applicant contends that independent Claims 21, 31 and 35 are now in proper condition for allowance. Additionally, those claims which are dependent upon

these independent claims should also be in condition for allowance. Reconsideration of the rejections and allowance of the claims at an early date is earnestly solicited. Since no new claims have been added above those originally paid for, no additional fee is required.

Respectfully submitted,

October 11, 2006

/s/ Andrew W. Chu

Date

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[0027] In the present invention, the separate angles of the first and second portions of the legs, along with the extended length of the first portion with respect to the second portion, will cause any thermal expansion to merely push the receiving area away from the wall of the structure. The minimal length of the second portion will result in minimal expansion effects upon the portion of the chair adjacent to the outer surface of the wall. As a result, the present invention greatly minimizes expansion effects.